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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/532,890	03/22/2000	Gian Fulgoni	032838-001	7977

21839 7590 11/04/2003

BURNS DOANE SWECKER & MATHIS L L P
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EXAMINER

REAGAN, JAMES A

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 11/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/532,890

Applicant(s)

FULGONI ET AL.

Examiner

James A. Reagan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 16.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Status of Claims

1. This action is in response to the amendment filed on 19 August 2003.
2. Claims 1-17 have been cancelled.
3. Claims 18-35 have been added
4. Claims 18-35 have been examined.

Information Disclosure Statement

5. The Information Disclosure Statement filed on 16 September 2003 has been considered. An initialed copy of the Form 1449 is enclosed herewith.

Specification

6. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code on at least pages 8, 14, and 16. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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8. Claims 18-35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, it appears that at least the following limitations are not disclosed within the specification:

- *receiving a request at the provider of services from a consumer to register with the provider of services to receive at least one of the offered incentives;*
- *registering the consumer with the provider of services;*
- *directing at least some of communications from the registered consumer's computer to a server of the provider of services;*
- *receiving at the provider of services data requests from the registered consumer's computer;*
- *recording at least part of the received data requests as associated with the unique identifier;*
- *communicating the received data requests to a data server capable of fulfilling the received data requests;*
- *receiving data in response to the received data requests from the data server;*

- *recording at least part of the received data as associated with the unique identifier;*
- *communicating the received data to the registered consumer's computer;*
- *aggregating the received data requests and received data associated with more than one unique identifier based on the recorded network activity of the registered consumers associated with the unique identifiers;*

The Applicant is respectfully requested to specifically point out in the specification (page and line number) where each of the aforementioned limitations is supported, as well as limitations contained in claims 19-35.

9. Claims 18-35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, it appears that at least the following limitations are not disclosed within the specification:

- *receiving a request at the provider of services from a consumer to register with the provider of services to receive at least one of the offered incentives;*

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- *registering the consumer with the provider of services;*
- *directing at least some of communications from the registered consumer's computer to a server of the provider of services;*
- *receiving at the provider of services data requests from the registered consumer's computer;*
- *recording at least part of the received data requests as associated with the unique identifier;*
- *communicating the received data requests to a data server capable of fulfilling the received data requests;*
- *receiving data in response to the received data requests from the data server;*
- *recording at least part of the received data as associated with the unique identifier;*
- *communicating the received data to the registered consumer's computer;*
- *aggregating the received data requests and received data associated with more than one unique identifier based on the recorded network activity of the registered consumers associated with the unique identifiers;*

The Applicant is respectfully requested to specifically point out in the specification (page and line number) where each of the

aforementioned limitations is supported, as well as limitations contained in claims 19-35.

10. Claims 18-35 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Specifically, it appears that at least the following limitations are not disclosed within the specification:

- *receiving a request at the provider of services from a consumer to register with the provider of services to receive at least one of the offered incentives;*
- *registering the consumer with the provider of services;*
- *directing at least some of communications from the registered consumer's computer to a server of the provider of services;*
- *receiving at the provider of services data requests from the registered consumer's computer;*
- *recording at least part of the received data requests as associated with the unique identifier;*
- *communicating the received data requests to a data server capable of fulfilling the received data requests;*
- *receiving data in response to the received data requests from the data server;*
- *recording at least part of the received data as associated with the unique identifier;*

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- *communicating the received data to the registered consumer's computer;*
- *aggregating the received data requests and received data associated with more than one unique identifier based on the recorded network activity of the registered consumers associated with the unique identifiers;*

These limitations are critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The Applicant is respectfully requested to specifically point out in the specification (page and line number) where each of the aforementioned limitations is supported, as well as limitations contained in claims 19-35. See *in re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1998) as appropriate. See also MPEP § 2164.01(a) and § 2164.04.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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12. Claims 18-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chelliah et al (US 5,710,887 A) in view of Scroggie et al (US 5,970,469 A).

Examiner's note: Examiner has pointed out particular references contained in the prior art of record in the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the *entire* reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Claims 18-35:

Chelliah discloses e-commerce (column 1, line 7), collecting demographic information about consumers (column 1, lines 33-34), incentives (column 4, line 16), maintaining customer information within a database (column 4, line 50). Chelliah does not specifically disclose registration, but Scroggie, in column 1, line 50 does. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Chelliah with Scroggie because this system provides a means for targeting customers with focused incentive-based promotions that increase profitability and customer satisfaction.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to **James A. Reagan** whose telephone number is **(703) 306-9131**. The examiner can normally be reached on Monday-Friday, 9:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **James Trammell** can be reached at (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 305-3900**.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 305-7687 [Official communications; including

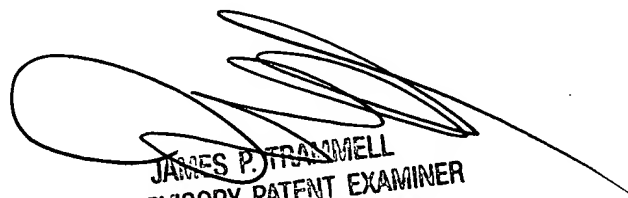
After Final communications labeled "Box AF"]

(703) 308-1396 [Informal/Draft communications, labeled

"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

JAR
17 October 2003


JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600